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In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 755

JOHN CLAYTON CRIDLEBAUGH,
Trading as Marvel Company,
Petitioner,

vs.

MAURICE L. RUDOLPH,
Trading as Rudolph Poultry Equipment Company,
Respondent.

Petition for Review on Writ of Certiorari and Brief in Support

To the United States Circuit Court of Appeals for the Third Circuit

JAMES M. NAYLOR,
THEODORE H. LASSAGNE,
Counsel for Petitioner,

RICHARD J. COOK,
Of Counsel.

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In the Supreme Court of the United States

OCTOBER TERM, 1942

No.....

JOHN CLAYTON CRIDLEBAUGH,
Trading as Marvel Company,
Petitioner,

vs.

MAURICE L. RUDOLPH,
Trading as Rudolph Poultry Equipment Company,
Respondent.

Petition for Review on Writ of Certiorari

To the United States Circuit Court of Appeals for the Third Circuit

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

This petition of John Clayton Cridlebaugh, trading as Marvel Company, respectfully prays that, in accordance with the provisions of the United States Code, Title 28, Section 347 (a), the United States Circuit Court of Appeals for the Third Circuit be required by writ of certiorari issued by the Supreme Court of the United

States, to certify to it for determination, the above-identified case in which the decision of the said circuit court of appeals was rendered on November 20, 1942.

SUMMARY STATEMENT OF MATTER INVOLVED

This petition presents questions relative to the validity of Jones Reissue patent 19,562, Cridlebaugh patent 2,079,107, and the validity of the word "Specs" as a common law trade mark, and the test of infringement to be applied thereto.

A. The Questions as to Validity of the Patents

1. The first question which petitioner asks to have reviewed and determined by this Court is whether in the absence of a challenge of validity by either of the parties to a suit for patent infringement, a court may nevertheless pass on that question.

(a) Assuming the primary question be answered in the affirmative, does the Jones Reissue patent No. 19,562 represent a patentable advance over the prior art?

(b) Assuming the primary question be answered in the affirmative, does the Cridlebaugh patent No. 2,079,107 represent a patentable advance over prior art?

The respondent, Rudolph, frankly conceded at the trial of the cause that he did not rely on any patent or prior use which could justify a contention that the claims of either of the patents (Jones Reissue 19,562 or Cridlebaugh 2,079,107) were anticipated. The Circuit Court of Appeals took the position that the fact that a defending

party to an infringement suit seeks to obviate the question of patentability of the disclosure involved does exclude that issue, that it inheres none the less in the charge of infringement, and held both patents anticipated by certain prior art patents.

2. The second question which petitioner asks to have reviewed and determined by this Court is whether the rule of *Permutit Company v. Grover Corporation*, 52 S. Ct. 53; 413 O. G. 1099; 11 Pat. Q. 118, operates to bar an applicant from claiming operational, as distinguished from structural, characteristics shown in his drawing but not specifically described in his specification.

The Circuit Court of Appeals took the position that rotary action of a certain securing member was neither "specified nor claimed" in the original Jones application despite the fact that such operational characteristic was clearly shown in the original drawing.

3. The third question which petitioner asks to have reviewed and determined by this Court is whether the introduction into a reissue claim of an operational, as distinguished from a structural characteristic, shown in the original drawings but not specifically described in the specification, makes the reissue claim one for a different invention than the original patent?

The Circuit Court of Appeals took the position that rotary action of a certain securing member in the patented device was neither "specified nor claimed" in the original Jones application despite the fact that such operational characteristic was clearly shown in the original Jones drawing, and construed the matter introduced by

the reissue claims as "an idea antagonistic to the disclosure of the original application", holding that the statute did not permit such procedure.

4. The fourth question which petitioner asks to have reviewed and determined by this Court is whether, as a matter of law, communication by an assignee of an interest, insufficient to enable him to control prosecution of an application for letters patent, to the inventor of the said assignee's belief of inadequacy of protection afforded by claims, prior to the issuance of an original patent, will bar subsequent, timely reissuance of the patent.

Jacob Jones, petitioner's assignor, filed application for letters patent on a Mask for Fowls on January 7, 1933. During the pendency of that application petitioner acquired a 49% interest in the invention. Prior to the grant of the original patent petitioner acquired a belief that broader claims than those asserted by Jones should be applied for and so informed Jones. The original patent issued on June 12, 1934 (1,962,395), on the basis of the narrow claims asserted by Jones. On July 12, 1934, pursuant to R-S 4916, U. S. C., Title 35, Sec. 64, Jones applied for reissue of the original patent to obtain broader claims and the reissue patent (19,562) was granted on May 7, 1935.

The Circuit Court of Appeals held it was difficult to see how Jones was in a position to make the requisite oath to a reissue application, viz., that the matter omitted from the original application was omitted therefrom through "inadvertence, accident or mistake".

B. The Validity of the Word "Specs" as a Common Law Trade Mark and the Test of Infringement to be Applied Thereto.

1. The fifth question which petitioner asks to have reviewed and determined by this Court is whether the word "Specs", as applied to Masks for Fowls, i.e., mechanical devices fitted on a chicken's beak and designed to partially obstruct forward vision on a horizontal plane as a means of preventing picking, is susceptible of exclusive appropriation as a trade mark at common law.

The Circuit Court of Appeals held that the word "Specs" is but a "figurative description" of the plaintiff's article of manufacture and does not grow out of either the origin or ownership of the goods, and that petitioner is not entitled to the exclusive use of the word or its synonyms.

2. The sixth question which petitioner asks to have reviewed and determined by this Court is whether having held that a plaintiff in a suit for infringement of a common law trade mark failed to establish a case of trade mark infringement, the court should nevertheless adjudicate the validity of the mark.

The Circuit Court of Appeals having held that the burden is on the one complaining to show by a fair preponderance of the evidence that the ordinary run of purchasers, giving that attention which such persons usually give to the buying of articles of the character involved, would likely be deceived, and that petitioner has failed to make out a case by a fair preponderance of the evidence, nevertheless declared the word "Specs" a "figurative description" of the petitioner's article and that peti-

tioner was not entitled to the exclusive use of the word or its synonyms.

3. The seventh question which petitioner asks to have reviewed and determined by this Court is whether in a suit for infringement of a common law trade mark it is sufficient for the plaintiff to show that a likelihood of confusion exists as distinguished from a showing that actual confusion has occurred.

The Circuit Court of Appeals, by its ruling, requires proof of actual confusion in trade as distinguished from showing a likelihood of confusion.

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT

This case presents questions of general importance relating to the interpretation of the patent laws and the law applicable to common law trade marks.

The United States District Court for the District of New Jersey held the Jones Reissue patent No. 19,562 and Cridlebaugh patent No. 2,079,107 both valid and infringed; held the trade mark "Specs" valid and infringed by the respondent's use of the synonym "Goggles", and held that the respondent had been guilty of unfair competition in his use of the word "Goggles" and his methods of advertising (decision reported at 40 F. S. 393).

The Circuit Court of Appeals in reversing the decision of the District Court, on all grounds, has decided the several questions presented in a manner which is submitted to be in conflict with the principles enunciated in relevant decisions of this Court.

The judicial discretion of this Court is invoked because of the general importance of the questions presented by this case, and by the disastrous effect of the decision of the Circuit Court of Appeals on the business of the petitioner. Additionally, petitioner represents that there is at present no conflict between decision of Circuit Courts relative to the subject matter hereof and there is no immediate prospect of such conflict, because, as petitioner represents, the respondent is petitioner's only competitor in the manufacture and sale of devices believed by petitioner to infringe the patents in suit and that consequently, further litigation is improbable.

> *Mackay Radio and Telegraph Co., Inc., v. Radio Corporation of America,* 306 U. S. 86, 40 U. S. P. Q. 199.

In cases involving an interpretation of the patent laws this Court has heretofore assumed jurisdiction for the purpose of review even in the absence of such conflict *(Exhibit Supply Co. v. Ace Patents Corporation,* 315 U. S. 126, 52 U. S. P. Q. 275).

Additionally, this Court has granted certiorari where the descriptive character of a trade mark was deemed of importance *(Armstrong Paint and Varnish Works v. Nu-Enamel Corp.,* 305 U. S. 315, 39 U. S. P. Q. 402), and where the decision is in conflict with decisions in other Circuit Courts of Appeals *(Beech-Nut Packing Co. v. P. Lorillard Co.,* 273 U. S. 629).

In so far as the decision of the Circuit Court of Appeals holds the word "Specs" invalid as a common law trade mark it is in conflict with the weight of authority as

shown by the decision of the Fourth Circuit Court of Appeals in *W. G. Reardon Laboratories, Inc. v. B & B Exterminators, Inc., et al.*, 71 F. (2d) 515 (holding "Mouse Seed" valid for rat poison); by the decision of the Seventh Circuit Court of Appeals in *Sierra Chemical Co. v. Berettini*, 33 F. (2d) 397 (holding "Rain Water Crystals" valid for a water softening compound); and by the decision of the Seventh Circuit Court of Appeals in *W. F. Burns Co. v. Automatic Recording Safe Co.*, 241 F. R. 472 (holding "Teller" valid for Safes).

In holding the reissue and original patents invalid, and the trade mark invalid and not infringed, the effect of the decision of the Circuit Court of Appeals will be to destroy the business of petitioner. Petitioner is shown by the evidence in the case to be engaged solely in the manufacture and sale of anti-picking devices for poultry, the articles forming the subject matter of the patent in suit and to be applying the trade mark "Specs" to those goods alone. Petitioner respectfully represents that it would be a miscarriage of justice if his business were completely destroyed by a decision based solely upon such an indefensible interpretation of the patent and trade mark laws.

The articles forming the subject matter of the patents in suit are Masks for Fowls. Specifically, the devices are blinders adapted to be attached to a chicken's beak to partially obstruct its forward vision on a horizontal plane as a means of preventing picking and, more particularly, cannibalism in poultry flocks. The problem solved by the devices of the patents in suit has been one of long standing and has occasioned great losses to the farmers, it being

demonstrable that the picking habit is contagious among members of a flock. The devices of the patents in suit are effective because they restrict the chicken's forward vision in a plane precluding cannibalistic tendencies while at the same time avoiding interference with normal nesting, feeding and drinking habits. The masks have been publicized by the U. S. Department of Agriculture and adopted universally by poultrymen and experimental poultry farms, because nothing in the prior art has approached the problem in the same way, a fact testified to by respondent's categorical withdrawal, by his statements during the trial, of any and all defenses with respect to anticipation pleaded in his answer.

Considering the stress of the times with respect to increased production of food supplies and the needless losses thereof prevented by the devices of the patents in suit, it is submitted that the subject matter hereof is of critical importance and the inventors, and those claiming under them, should not, except in a clear case, be deprived of their just rewards for such a meritorious contribution.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the Circuit Court of Appeals for the Third Circuit, commanding that Court to certify and to send to this Court for its review and determination on a day certain to be therein named, a transcript of the record and proceedings herein; and that judgment of the said Circuit Court of Appeals for the Third Circuit be reversed by this Honorable Court, and that your petitioner have such other and further relief

in the premises as to this Honorable Court may seem meet and just.

JAMES M. NAYLOR,
THEODORE H. LASSAGNE,
Counsel for Petitioner.

RICHARD J. COOK
Of Counsel.

Brief in Support of Accompanying Petition for Certiorari

THE OPINION BELOW

The opinion rendered by the United States District Court for the District of New Jersey is reported at 40 F.S. 393 and appears in the Transcript filed concurrently herewith.

The opinion of the United States Circuit Court of Appeals for the Third Circuit (by Jones, C. J.) is reported at ..... Fed. (2d) ....., and likewise appears in the accompanying Transcript.

THE JURISDICTION

The judgment, a review of which is sought, was rendered November 20, 1942. The authority of this Court is invoked under the provisions of the United States Code, Title 28, Section 347 (a) and of Rule 38 of this Court.

STATEMENT OF THE CASE AND SPECIFICATION OF ERRORS

The petitioner, by virtue of assignment, is the owner of Jones Reissue patent 19,562 for Mask for Fowls, reissued on May 7, 1935. Petitioner is also the patentee and owner of Cridlebaugh Patent 2,079,107, for Device for Preventing Picking in Poultry, granted May 7, 1937. To the commercial embodiments of the subject matter of these two patents petitioner applies the common law trade mark "Specs". (Note: Petitioner registered the trade mark

"Hen Specs" in the United States Patent Office, No. 379,108, dated July 2, 1940, pursuant to the provisions of the Act of February 20, 1905, as amended (U. S. C. title 15, Sec. 81, et sequentia) but no complaint is predicated thereon, the registration having been obtained after this suit was filed (October 26, 1938).)

The suit charges respondent with infringement of the reissue and original patents in suit; with infringement of the common law trade mark "Specs" in the use of the synonym "Goggles", and with unfair competition arising out of respondent's use of the infringing mark "Goggles" and certain methods of advertising. Respondent filed a counterclaim but with that we are not concerned for the purposes of this petition.

The United States District Court for the District of New Jersey held both the reissue and original patents valid and infringed; held the trade mark "Specs" valid and infringed by respondent's use of the synonym "Goggles", and held that the respondent had been guilty of unfair competition in his use of the word "Goggles" and his methods of advertising. The Circuit Court of Appeals reversed as to all grounds.

The errors relied upon as ground for review and reversal of the decision of the court below, are as follows:

1. The Court below erred in holding that even in the absence of a challenge of validity by either of the parties to a suit for patent infringement, a court may nevertheless pass on that question, and in holding the reissue and original patents in suit anticipated by prior art patents discarded by the respondent at the trial.

2. The court below erred in holding, in effect, that an applicant is barred from claiming operational, as distinguished from structural, characteristics shown in his drawing but not specifically described in his specification.

3. The court below erred in holding that the introduction into a reissue claim of operational, as distinguished from structural, characteristics shown in the patentee's drawing but not specifically described in his original specification is not permitted by the statute and in holding the Jones Reissue patent No. 19,562, for that reason, invalid.

4. The court below erred in holding that communication by an assignee of an interest insufficient to enable him to control prosecution of an application for letters patent, to the inventor of said assignee's belief of inadequacy of protection afforded by claims, prior to the issuance of an original patent, will bar subsequent, timely reissuance of the patent.

5. The court below erred in holding that the word "Specs", as applied to Masks for Fowls, i. e. mechanical devices fitted on a chicken's beak and designed to partially obstruct forward vision on a horizontal plane as a means of preventing picking, is but a "figurative description" of the plaintiff's article of manufacture and does not grow out of either the origin or ownership of the goods and that petitioner is not entitled to the exclusive use of the word or its synonyms.

6. The court below erred in holding that in a suit for infringement of a common law trade mark a court may adjudicate the validity of the mark despite a concurrent holding that the plaintiff (petitioner here) had failed to establish a case of trade mark infringement.

7. The court below erred in holding that in a suit for infringement of a common law trade mark the plaintiff must show that actual confusion has occurred as distinguished from a showing that a likelihood of confusion exists (i. e., the use of a word mark and its synonym).

ARGUMENT

A. The Questions as to Validity of the Patents

1. In passing on the validity of the Jones Reissue patent No. 19,562 and Cridlebaugh patent No. 2,079,107, the Circuit Court of Appeals said:

> "While the defendant at trial made reference to the art as it existed prior to Jones, he studiously refrained from citing it as anticipation. The reason for his so doing is not hard to perceive. The defendant's patent (No. 2,181,070) granted November 21, 1939, and under which he manufactured and sold his accused device, is so similar in principle to the Jones and Cridlebaugh devices that he undoubtedly hesitated to assail the Jones and Cridlebaugh patents on the ground of anticipation lest he, at the same time, inpugn his own patent. But the fact that the defending party to an infringement suit seeks to obviate the question of patentability of the disclosure involved does not exclude that issue. It inheres none the less in the charge of infringement. In such instance the parties are powerless to foreclose the court from determining whether the patent does in fact cover invention. The duty to protect the public from the imposition of an unwarranted monopoly requires no less. See Densmore v. Schofield, 102 U. S. 375,378.

From the foregoing it will be seen that the Circuit Court of Appeals has, on its own motion, applied certain prior art patents to *anticipate* the reissue and original letters patent in suit, although the respondent did not deem them sufficient to justify a contention that the claims of either of the patents were anticipated and categorically withdrew, by his statement during the trial, any and all defenses with respect to anticipation pleaded in his answer.

Concededly, the prior art patents were available to the Circuit Court of Appeals *as evidence showing the state of the art* to aid in the proper construction of the patents in suit, but petitioner respectfully submits that the principles underlying the requirement of the statute (R. S. 4920, U. S. C. Title 35, sec. 69) that notice be given of any defense by way of prior patents, publications, or public use relied on to show want of novelty or invention, are as applicable to the courts, acting on their own motion, as they are to the parties to a suit.

Grier v. Wilt, 7 S. Ct. 718, 120 U. S. 412, 30 L. Ed. 712;

Eachus v. Broomall, 6 S. Ct. 229, 115 U. S. 429, 29 L. Ed. 419.

The reason for the requirement of the notice (R. S. 4920, U. S. C. Title 35, Sec. 69) is to guard the patentee from being surprised on the trial by evidence of a nature which he could not be presumed to know or to be prepared to meet *(Teese v. Huntingdon,* 23 How. 2, 16 L. Ed. 479; *Blanchard v. Putnam,* 8 Wall. 420, 19 L. Ed. 433) and the patentee is none the less surprised that a District Court, or a Circuit Court of Appeals on appeal, on the court's

own motion, injects the question of anticipation than if the defendant failed to give the requisite notice.

Referring particularly to the Cridlebaugh patent 2,079,-107, it should be noted that, on appeal to the Third Circuit Court of Appeals, the respondent did not challenge validity on *any grounds*, for which reason it was error for the Circuit Court of Appeals, on its own motion, to pass on that question. See:

> *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126.

2. The second question presented by the accompanying petition relates to the disclosure requisite in a patent application to support the claims asserted.

Petitioner contends that when an operational, as distinguished from a structural, characteristic of a device is shown in the drawing accompanying and forming a part of a patent application, the applicant may claim such operational characteristic even though it is not specifically described in his specification.

The governing statute (R. S. 4888, U. S. C., title 35, sec. 33) calls for a disclosure sufficiently clear to

> "* * * enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same * * *."

Where any "good mechanic" acquainted with the subject matter, and having the drawing before him, would have no difficulty in adopting the improvement, it can-

not be said the disclosure is inadequate *(Ives, et al. v. Hamilton,* 92 U. S. 426).

The test to be applied is whether the device embodies the generic principle and works *(Hildreth v. Mostoras,* 257 U. S. 27, 34; *Telephone Cases,* 126 U. S. 1, 535). Thus mere failure to specifically describe or illustrate in the drawings the final, operative form of the invention will not invalidate a claim when the disclosure contemplates adjustment or change in a degree sufficient to accomplish the objects of the invention *(Johnston v. Woodbury,* 109 F. R. 567 (C. C. A. 9th)).

Defining a pin as a "pivot" or as permitting a "swinging movement" of the device retained thereby, when these operational characteristics are inherent in the device illustrated, does not violate the rule against new matter. *Safeway Steel Scaffolds Co. v. Patent Scaffolding Co.,* 110 F. (2d) 1008 (C. C. A. 7); *Wezel & Naumann Aktiengesellschaft v. Morgan Lithograph Co.,* 54 F. (2d) 235 (C. C. A. 2).

3. The third question relates to the reissue practice. It is petitioner's contention that here the reissue claims merely introduced an operational characteristic shown in the original drawings though not specifically described in the specification. As such the case will at once be seen as presenting an entirely different problem from one in which there was no disclosure at all of the matter of the reissue (cf. *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.* 315 U. S. 668, 676).

Here petitioner is relying upon the drawings of the original Jones patent 1,962,395 as evidence of the fact

that the reissued patent (19,562) is for the same invention as the original patent and as the foundation for the right to introduce in the reissue application claims drawn to the operational characteristics of that device depicted in the drawings. It is submitted that this is proper reissue practice.

Woolwine Metal Products Co. v. Boyle, 279 F. R. 609, 611 (C. C. A. 9th);

Perfection Disappearing Bed Co., Inc. v. Murphy Wall Bed Co., 266 F. R. 698 (C. C. A. 9th).

The claims introduced in the reissue in the present case attribute a pivotal operation to a pin member and the drawing in the original application plainly shows the pin to have such characteristic. The mere fact that another and different element had theretofore been defined as having a different pivotal operation does not alter the situation.

The fact that the operational characteristic is inherent in the thing exhibited in the drawing is believed to be the controlling factor and the right to cover such characteristic in reissue claims is believed clear.

Topliff v. Topliff, 145 U. S. 156, 170; 12 Sup. Ct. 825, 831;

Prescott v. Swain, 22 F. (2d) 1004.

Clearly the introduction of the characteristic in the reissue claims cannot be said to violate the rule against the insertion of "new matter". *Wezel & Naumann Aktiengesellschaft v. Morgan Lithograph Co.,* supra, and *Safeway Steel Scaffolds Co. v. Patent Scaffolding Co., et al.,* supra.

4. Petitioner herein was the assignee of a 49% interest in the subject matter of the original Jones patent No. 1,962,395 during the pendency of the application. Prior to issuance of that patent he acquired the belief that the claims then asserted by Jones did not adequately protect the invention and communicated that belief to Jones. The original Jones patent then issued (June 12, 1934) on the basis of the claims questioned by petitioner. One month later (July 12, 1934) Jones applied for reissuance of the patent introducing the claims in suit of the scope suggested by petitioner and the grant of the reissue patent followed (Reissue patent No. 19,562, May 7, 1935). It will be noted that the reissue application was filed within *one month* of issuance of the original patent, precluding any contention as to untimeliness.

The Circuit Court of Appeals took the position that it was:

> "indeed difficult to se how Jones was in a position to make the requisite oath to a reissue application, viz., that the matter omitted from the original application was omitted therefrom through 'inadvertence, accident or mistake', etc."

It is axiomatic that petitioner, as assignee of a 49% interest could not control the prosecution of the application to the exclusion of Jones, under the Patent Office Rules of Practice promulgated by the Commissioner of Patents pursuant to Revised Statutes, Secs. 481, 483, 489 and Executive Order of March 17, 1925, 332 Off. Gazette 957.

Rule 5 thereof reads as follows:

> "The assignee of *the entire interest of an invention* is entitled to hold correspondence with the office to the exclusion of the inventor."

Rule 20 reads, in part, as follows:

> "* * * an assignment will not operate as a revocation of the authorization previously given, *but the assignee of the entire interest* may be represented by an attorney or agent of his own selection."

Since petitioner himself, as the assignee of a part interest in the invention, could not have asserted claims of the order he believed proper in the case, it is impossible to perceive how mere communication of his belief as to inadequacy of the claims, without evidence as to Jones agreement or disagreement in such belief, would bar the applicant (Jones) from asserting such claims as promptly as he did by reissue application filed *one month* after the date of issuance of the original patent.

This seems particularly so in view of the fact that the Patent Office tribunals have consistently held that the applicant's statements in the reissue oath that he has obtained insufficient claims in his patent to cover the invention is a valid ground for reissue (*Ex Parte Smith*, 44 U. S. P. Q. 546; *Ex Parte Walker*, 40 U. S. P. Q. 578; *In Re Briede*, 27 App. D. C. 298) and a similar rule has been followed by the Courts (*Robert v. Krementz*, 243 F. R. 877, 881 (C. C. A. 3) and *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 F. 698, 699 (C. C. A. 9) both citing *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658).

It is obvious that to say that the Jones Reissue patent No. 19,562 could not be reissued will operate with great hardship upon petitioner who has since acquired all right and title to the patent (*Topliff v. Topliff*, supra).

B. The Validity of the Word "Specs" as a Common Law Trade Mark and the Test of Infringement to be Applied Thereto.

1. This Honorable Court has heretofore taken occasion to lay down the test of a valid, technical common law trade mark. This Court has held that one of the rules to be followed is that a generic name, or a name *merely descriptive* of an article of trade, of its qualities, ingredients, or characteristics, cannot be employed as a trade mark and the exclusive use of it be entitled to legal protection (*Canal Co. v. Clark*, 80 U. S. 311, 323).

This Court has also recognized that the term "trade mark":

> "* * * has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular manufacturers may be distinguished from those of others. It may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."
>
> *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 673.

In the face of these and similar pronouncements by this Court the Circuit Court of Appeals held that the word "Specs" as applied to petitioner's goods was but a "figurative description" and did not grow out of either the origin or ownership of the goods and that plaintiff was not entitled to the exclusive use of the word or its synonyms.

Petitioner has searched in vain for judicial interpretation of the expression "figurative description". If taken at its generally accepted and dictionary definition the word "figurative" must be understood as used in its metaphorical sense; then the term "figurative description" would mean that "Specs" is not a literal description of petitioner's articles. That being so "Specs" would not be "merely descriptive" (*Canal Co. v. Clark*, supra) but rather suggestive and requiring some independent thought to attribute to it the slightest significance as to petitioner's goods.

Considering the generally accepted colloquial meaning of the word "Specs" (i.e., short for spectacles) the word must be regarded as having an incongruous significance when applied to a Mask for Fowls, viz. a mechanical device attached to a chicken's beak and designed to partially *obstruct* the forward vision of the fowl on a horizontal plane to prevent picking. That suggestive marks of this character have long been regarded as valid, technical marks, see

Sierra Chemical Co. v. Berettini, 33 Fed. (2d) 397 (C. C. A. 7th);

Roberts v. Sheldon, 8 Bissell 398, Fed. Case No. 11916, 18 O. G. 1277; 1880 C. D. 676 (C. C. Ill.);

Selchow v. Baker, 93 N. Y. 53, Cox 690 (Ct. of App. N. Y. 1888);

Globe-Wernicke Co. v. Brown et al., 121 F. R. 185;

United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 F. 456, 460;

Automatic Recording Safe Co. v. Banker's Registering Safe Co., 224 F. R. 506;

W. F. Burns Co. v. Automatic Recording Safe Co., 241 F. R. 472, 487 (C. C. A. 7th);

Waltke & Co. v. Schafer & Co., 263 F. R. 650;

W. G. Reardon Laboratories, Inc. v. B & B Exterminators, Inc., et al., 71 F. (2d) 515 (C. C. A. 4th);

Stoughton v. Woodward et al., 39 F. R. 902;

Eiseman v. Schiffer, 157 F. R. 473.

2. The Circuit Court of Appeals adjudged the mark "Specs" invalid as a common law trade mark despite a concurrent holding that the plaintiff (petitioner here) had failed to establish a case of trade mark infringement.

Petitioner submits that having found that a case of infringement had not been made out the Circuit Court of Appeals should have dismissed the bill without more. The respondent having in its favor a decree of non-infringement of the petitioner's common law trade mark had all the relief to which it was entitled. Analogy can be drawn to the decision of this Court in *Electrical Fittings Corp. et al. v. The Thomas & Betts Co. et al.*, 307 U. S. 241, 59 Sup. Ct. 860.

3. The Circuit Court of Appeals held that in a suit for infringement of a technical, common law trade mark,

> "the burden is on the one complaining to show by a fair preponderance of the evidence that the ordinary run of purchasers, giving that attention which such persons usually give to the buying of articles of the character involved, would likely be deceived."

and ruled that the plaintiff (petitioner here) had, in producing evidence of only a limited number of cases of *actual confusion*, failed to make out a case by a fair preponderance of the evidence either as to confusion of the buying public or deception by the defendant. The effect of the decision is to require *actual evidence of confusion* sufficient to constitute a fair preponderance of the evidence, as distinguished from a *likelihood of confusion.*

In so ruling the Circuit Court of Appeals has cast upon petitioner a greater burden than properly attends such cases. It is submitted that the rule applicable in cases of technical trade mark infringement is that proof of actual deception of purchasers is unnecessary if the trade marks so resemble each other that it is likely or probable in the sale of the goods that one will be mistaken for the other.

Nims on Unfair Competition and Trade Marks, Second Edition, Sec. 335;

Bissell Chilled Plow Works v. T. M. Bissell Plow Co., 121 F. 357;

Tumble v. Woodstock Mfg. Co., 297 F. 524, 529;

The Best Foods, Inc. v. Hemphill Packing Co., 5 F. (2d) 355, 357;

Walter Baker & Co. v. Delapenha, 160 F. R. 746, 749.

In showing use by respondent of the synonym "Goggles" in the face of prior use of "Specs" for the identical goods petitioner has met the proper test (cf. *Coca Cola Co. v. The Koke Co. of America, et al.*, 254 U. S. 143).

Respectfully submitted,

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(35)

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IN THE

Supreme Court of the United States

October Term, 1942.

No. 755.

JOHN CLAYTON CRIDLEBAUGH, Trading as Marvel Company,
Petitioner,

vs.

MAURICE L. RUDOLPH, Trading as Rudolph Poultry Equipment Company,
Respondent.

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BRIEF OF RESPONDENT.

Petitioner, John Clayton Cridlebaugh, has filed a petition for a writ of certiorari, addressed to the United States Circuit Court of Appeals for the Third Circuit, directing the certification to this court of the records in the case of Cridlebaugh vs. Rudolph reported in 131 Fed. (2nd) 795, decided November 20, 1942.

The opinion of the Court of Appeals (R. 195) contains a full statement of the case as it was presented by the appeal

record. It is deemed unnecessary to repeat it here. However, in view of certain issues raised by the petition at bar, it should be particularly noted that in the answer (R. 15a) defendant denied validity of the Jones reissue patent in view of six prior U. S. patents which are specifically enumerated. Also (R. 18a) that the answer set up five alleged prior art patents, including the original patent to Jones as anticipatory of the Cridlebaugh patent. The answer also challenged the sufficiency of the reissue oath (R. 17a).

The record does not show that the patents referred to by the Appellate Court in its opinion (R. 202) were discussed by any witness. It does show that they are in evidence as Exhibits 164a and Exhibits 166a to 171a. Further, the record fails to show that the petitioner made any objection whatever to the entry of these exhibits in evidence or consideration thereof by the Trial Judge.

The District Judge (R. 134a to 155a) without passing on the question of validity in view of prior art, sustained the charge of infringement of the two patents and of the trade mark, sustained the charge of unfair competition, and dismissed the counterclaim for libel, all of which will more fully appear in the opinion and Findings of Fact and Conclusions of Law. The usual interlocutory decree for injunction followed (R. 3) and injunction duly issued. From this judgment, respondent appealed.

The Circuit Court of Appeals, by written opinion, commencing Record page 195, reversed the District Court, holding that each of the patents in suit, i.e., the Jones Reissue No. 19,562 and the Cridlebaugh patent No. 2,079,107, was invalid in view of the above mentioned prior art patents, contained in the record before it; that the Jones reissue patent is invalid because (1) the facts of record show that Jones was not in a position to make a valid reissue oath (R. 197); and (2) that the original patent did

not disclose the subject matter of the reissue claims (R. 199, 200). The lower Court also held that Petitioner's trade mark "Specs" is descriptive and therefore not a valid mark, that it was not infringed, and that unfair competition had not been proved.

THE PETITION FOR WRIT OF CERTIORARI DOES NOT MEET THE REQUIREMENTS OF RULE 38.

The petition at bar is open to the objection that it fails to meet any of the requirements of Rule 38, Section 5. For instance, although seven separate grounds for review are alleged, there is no charge that the Court of Appeals has decided any federal question of substance not previously determined by this court. The petition also fails to show that any decision of the United States Court of Appeals for the District of Columbia is involved in the present case. The petition therefore definitely fails, so far as the requirements of paragraphs 5(a) and 5(c) of Rule 38 are concerned.

The petition also fails to definitely set up any ground justifying review by this court under the provisions of paragraph 5(b) of the Rule. Petitioner concedes (p. 7 of the combined petition and brief) that "there is at present no conflict between decisions of Circuit Courts relative to the subject matter here involved." Aside from this, there is no charge that the case at bar involves the decision of any important question of local law. Nor is it charged that the lower court has decided any important question of federal law which has not been, but should be settled by this court. There is no charge that the lower court has decided any federal question in a way probably in conflict with applicable decisions of this court. Neither

is there any showing by cited authority that the lower court has so far departed from accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court as to call for an exercise of the power supervision of this court. Therefore, it does not affirmatively appear that the petition sets up any of the accepted grounds upon which this court customarily issues a writ of certiorari.

The First Question.

The first question which the petitioner seeks to have reviewed and determined is "whether in the absence of a challenge of validity by either of the parties to a suit for patent infringement, a court may nevertheless pass on that question."

In support of this question, the Petitioner takes the ground that because Respondent's brief in the Court of Appeals did not seriously urge the invalidity of either of the patents in suit, that said court was precluded from passing upon the validity of these patents. Petitioner has not cited any case decided by this court or any other court which even remotely supports this position. In fact, as will be pointed out later, the weight of authority is to the contrary.

In the case at bar, the patents considered by the Court of Appeals to invalidate the two patents in suit were offered in evidence during the trial, were before the trial Judge at all times thereafter, and were certified to the Court of Appeals as a part of the appeal record.

The jurisdiction of the Appellate Court is found in U. S. C. Title 28, section 227a. This statute clearly relates the jurisdiction of the Appellate Court to the issue of an interlocutory injunction. Under the present Rules of Civil

Procedure no assignment of error is required when an appeal is taken. Therefore, on the record certified to the court, the broad issue is whether the facts of record justify the issue of an injunction.

In the case at bar the Circuit Court of Appeals based its authority for reviewing the prior art in the record before it and finding invalidity of the patents on the broad ground of public policy, citing Densmore vs. Scofield, 102 U. S. 375, 378. While this ground alone seems to be sufficient for the purposes of this case, the court could have cited other cases which deal specifically with the question raised by the petitioner's first point. In the case of *Millard vs. Chase,* 108 F. R. 399, 401, the Circuit Court for the First Circuit had before it an appeal from a decision of the lower court in which a patent was found to be valid and infringed, notwithstanding the existence of a certain prior art patent to one Powell, which the Trial Court considered "too remote as an anticipation." With the record which went before the Appellate Court two other prior art patents were included, but they were not stressed in the argument before the court, the appellants having rested their case on the patent to Powell. Thus, the circumstances closely parallel those of the case at bar. With respect to this situation, the court said:—

> "It is a thoroughly settled rule as to patentability, and the range of the claims in a patent, *inasmuch as these matters concern the public at large, the court will not allow parties to frame their issues in such a way as to take from it the scrutiny of all of the questions which may be involved.* The rule applies to this case, and requires us to examine the range of the claims, and all the material questions involved in the patentability of the process in controversy." (Italics ours).

The court went on further to comment that the rule applied to the case before it and that it declined "to rest it where the respondents offered to rest it."

The court further pointed out (page 404) that:—

> "This appeal comes to us as an injunction issue, with a decree for accounting, after a hearing on bill, answer and proofs. Therefore, in accordance with settled practice, the merits of the case are fully before us, and we are enabled to dispose of it finally."

The case of *Millard vs. Chase, supra,* was cited with approval and followed in the case of *U. S. Consolidated Seeded Raisin Company vs. Selma Fruit Company,* 195 F. R. 244 (C. C. A. 9). Other cases in point are: *Linde Company vs. Morse Company,* 246 F. R. 834, 837 (C. C. A. 2); *Burroughs Adding Machine Co. vs. Rockford Milling Machine Co.,* 292 F. R. 550 (C. C. A. 7); *Herman Body Co. et al vs. St. Louis Body & Equipment Co. et al.,* 46 F. (2) 879 (C. C. A. 8); *Mills Novelty Co. vs. Monarch Tool & Mfg. Co.,* 49 F. (2) 28, 29 (C. C. A. 6); *Aero Equipment Corp. vs. Herring Wisler Co.,* 84 F. (2) 619; and *Willemette-Hyster Co. vs. Pacific Car & Foundry Co.,* 122 F. (2) 492, 499 (C. C. A. 9).

These opinions are unanimous in holding that an appeal in equity brings before the Appellate Court the entire record and that in accordance with settled practice, *the merits of the case are fully before the court for final disposition.* Certainly, in view of the facts of record, the Appellate Court in the case at bar would not have been justified in upholding infringement of either of the patents in suit, if the appeal record contained convincing evidence that the patents were invalid. To have affirmed infringement of patents which the court considered invalid, would have been a miscarriage of justice.

On page 23 of the record and brief, petitioner cites the case of *Electrical Fittings Corporation et al vs. Thomas &*

Betts et al, 307 U. S. 241, asserting that analogy can be drawn to that decision. This position is untenable because in the Electrical Fittings case, *supra,* the District Court held claim 1 valid and claim 2 invalid and entered a decree dismissing the bill for failure to prove infringement. The plaintiff did not file an appeal, but filed a disclaimer in the United States Patent Office. The defendant filed an appeal from so much of the decree as adjudicated claim 1 valid. This court held that the Court of Appeals "had jurisdiction to entertain the appeal, not for the purpose of passing on the merits, but to direct reformation of the decree." It will be seen therefore that only questions of formality were involved in the Electrical Fittings case, and that the conditions were very different from those of the case at bar. In view of the settled practice, as set forth in the cases hereinbefore cited, there does not appear to be any justification under the Electrical Fittings case for this court to take jurisdiction.

The Second and Third Questions.

The second question which the petitioner asks to be reviewed is whether the rule of *Permutit Company vs. Grover Corporation,* 284 U. S. 53,

> "operates to bar an applicant from claiming operational as distinguished from structural characteristics shown in the drawing but not specifically described in his specification."

This question is somewhat misleading because it is directed at that part of the opinion of the Court of Appeals (R. 199, 200) finding that the original patent to Jones No. 1,962,395 (R. 164a) contains insufficient disclosure to sup-

port the matter which was introduced and claimed in the reissue patent.

The opinion below raises no question as to the adequacy of disclosure of the original Jones patent with respect to the claims thereof. The conclusion on this subject was *definitely limited to the failure of the original patent to support the new matter inserted in the Jones Reissue patent No. 19,562.* This is the issue raised by the third question. Therefore, Points No. 2 and No. 3 will be discussed together.

The third question is whether the lower court erred in holding that the introduction into a reissue claim of operational, as distinguished from structural characteristics shown in the drawing of the original patent is not permitted by statute, and further, that the court erred in holding the Jones Reissue patent No. 19,562 invalid for that reason.

The lower court stated (R. 199):

> "The present is not a case of including in the reissue application something inherent or incidental to the device originally disclosed. It is precisely the opposite and is an attempt to include an idea antagonistic to the disclosure of the original application."

The rule is well settled that the provisions of *Section R. S. 4888 U. S. C. Title 35, Section 33,* calls for a disclosure sufficiently clear to "enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same." This rule has been repeatedly stated by this court, and was again restated in the Permutit case above cited, and in the case of *Schriber-Schroth vs. The Cleveland Trust Company et al,* 305 U. S. 47. In the last mentioned case, this court found that the application of the patent in issue, which appertained to a piston for internal combustion engines provided with laterally disposed webs, *contained no reference in terms to flexibility of the*

webs, or to the *function of the webs to secure flexibility of the skirt of the piston.* It was also found that neither the drawings nor the specifications of the patent in suit contained dimensions showing thickness or other proportions which might suggest a flexible structure.

In the case at bar, the original Jones patent 1,962,395 (R. 16a) contains no reference whatever to any rotative mounting of the mask upon the pin 17, i.e. a rotative movement forwardly and backwardly with respect to the head of the fowl. The patent drawing negatives any such function, because the pin 17 is shown as a flat pin with the narrow edges at the top and bottom, and there is no clear indication of the shape of the holes 16 through which the pin passes. The specification, page 1, commencing at line 60, merely states that the securing means is a pin 17 "adapted to extend through aligned holes 16 and also through the breather opening in the beak B."

The issue raised here does not relate to the sufficiency of the disclosure of the original patent for the purposes of the claims thereof. That is a moot question. The issue is, however, directly related to the sufficiency of the original disclosure to support the matter introduced for the first time in the reissue patent in the way of amplification of the specification and broadened claims.

This court has many times held that interpolations in a reissue patent of new features or ingredients or devices which were neither described, suggested, nor substantially indicated in the original specifications, drawings, or Patent Office model, render the reissued patent invalid. Many cases could be cited, but typical examples are *Seymour vs. Osborne,* 78 U. S. 516; *Miller vs. Brass Company,* 104 U. S. 350; *Corbin Cabinet Lock Co. vs. Eagle Lock Co.,* 150 U. S. 38, 42; *McCormick Harvesting Machine Co. vs. Aultman,* 168 U. S. 606, 610; *U. S. Industrial Chemicals Inc. vs. Carbide & Carbon Chemicals Corp.,* 315 U. S. 668, 676.

Exception is taken by petitioner to the statement in the opinion of the Court of Appeals (R. 198) as follows:

> "The intent and effect of the added paragraph of specification in the reissue application was to import to the pin or securing member a pivotal function in the rotation of the pin from the tipping of the top of the mask forwards or backwards due to the movement of the fowl's head, thereby causing removal of dust and dirt which would otherwise collect on the pin where it enters and leaves the breather opening in the beak".

As indicated (R. 199) *it is that pivotal function of the pin* which the plaintiff relies upon specially for alleged novelty of the invention, and as a support for his charge of infringement.

Petitioner's position is that this new matter is an operational as distinguished from a structural characteristic. This is immaterial. Schreiber-Schroth v. The Cleveland Trust Co. et al, *supra*. It will be observed, however, that it is in fact a structural characteristic, because if the mask were not mounted freely for this pivotal movement and so described in the original specification, *it would not be free to perform the functions attributed to it in the reissue case.* The pin 17 is flat and there is not the remotest description in the original patent of any correlated structure by which the pivotal movement is obtained, or anything to indicate that this alleged rotative function is an inherent characteristic.

The action of the Court of Appeals on these issues is definitely within the purview of the decisions of this court. The contention of the petitioner with respect to Questions No. 2 and No. 3, therefore, is absolutely without merit.

The Fourth Question.

The fourth question raises an issue with respect to that portion of the opinion of the lower court (R. 197) where it was held that Jones was not in a position to make the requisite oath to the reissue application which resulted in the grant of the Jones reissue No. 19,562. The facts appearing of record are that prior to the issue of the Jones patent No. 1,962,395 (R. 164a) Cridlebaugh (owning a 49% interest) warned Jones that his protection was inadequate (R. 72a), and advised him to attempt to get broader claims *"before it was too late."*

Cridlebaugh admits (R. 69a) that it was his suggestion that the reissue was filed (XQ. 319), and that he collaborated with the patent solicitor in the preparation of the reissue application (XQ. 321 to 324). Respondent calls attention to XQ. 330 (R. 71a) and the answer, and particularly to that portion appearing on Record 72a. Also, note that in his answer to XQ. 331 (R. 72a) Cridlebaugh admits that at that time he had in mind what he considered the shortcomings of the Jones patent.

The reissue oath is not a part of the record certified to this court, although it was a part of the record before the Court of Appeals. However, the references thereto in the record at pages 71a and 73a, XQ. 350; page 75a, XQ. 357, clearly indicate the lack of good faith on the part of Jones in making his reissue oath. Cridlebaugh also admits (R. 75a, XQ. 360 and 361) that the Jones original patent shows a square pin, but that he is unable to find any place in the specification which describes the pivoting action.

Petitioner challenges the warning given Jones by a part owner of his application, as being insufficient to justify the finding that Jones was not in position to make the reissue oath. It is the position of Respondent that *it is wholly im-*

material whether Cridlebaugh owned any interest at all in the original Jones application if, as a matter of fact, he had warned the applicant Jones, *as he did after careful examination of his application,* of certain specified inadequacies of the protection of his pending application. In the face of this warning Jones proceeded at his own risk, and issued his patent without attempting to correct the inadequacies. Even after Cridlebaugh's notice he failed to take any action until after his patent issued, whereupon within a short time, abetted by Cridlebaugh, he filed an application for reissue, supporting it by making oath to facts which were inconsistent with his previously acquired knowledge. The Court of Appeals correctly found that because of this pre-knowledge, *Jones was not in a position to make oath that the inadequacies were unknown to him until after issue of the original patent.* The fact that Cridlebaugh had a definite interest in the patent application, with the contemplation that he would later manufacture the device, lent much greater legal force to his warning.

The reissue oath should have been included as a part of the record certified to this court. It is not here, and this court, therefore, is without the full facts. Petitioner has not overcome the *prima facie* effect of the correctness of the decision of the Court of Appeals in this respect, arising from the fact that said court had all of the record before it.

Petitioner, (page 8) asks this court to take jurisdiction because of the alleged "disastrous effect of the decision of the Circuit Court of Appeals on the business of the petitioner".

Petitioner, however, fails to point to any part of the record which supports this contention. Neither Respondent nor the public generally should be penalized because petitioner has gambled with his patent protection by bringing an ill-advised suit in the federal courts for infringement thereof, under conditions which would result in the chal-

lenge of validity. This act was voluntary on his part and he is now in no position to complain.

The record in this case fails to show any special circumstances within the purview of the cases cited by Petitioner on page 7, and his argument in this particular is without merit.

The fourth question is without merit.

The Fifth Question

Under this heading, petitioner asks this court to review the finding of the Court of Appeals to the effect that petitioner's trade mark "Specs", as applied to masks for fowls, is a descriptive mark and that, therefore, the petitioner is not entitled to the exclusive use of the word or its synonyms (R. 203, 204).

That the mark is descriptive *per se* is tacitly admitted by petitioner (page 13), where he asserts error in the holding that he is not entitled to the exclusive use of the word "Specs" or its "synonym." There could be no synonym of "Specs" if it were not a descriptive word.

However, the real position of petitioner (page 22 of his brief) is that the descriptive sense of the word "Specs", as applied to the inventions involved in the case at bar, is incongruous. Numerous authorities are cited allegedly upholding this principle. It is not denied here that the authorities cited in the main correctly state the principle of law, but it is Respondent's position that these cases are not similar to the case at bar. They cite examples that could not be considered descriptive, without doing violence to common sense.

The situation is different here. For instance, the opinion below (R. 196), points out that Petitioner's devices are attached to the beaks of the fowl *for the purpose of obstruct-*

ing their forward vision. This is not denied. The word "Specs" implies a device to be used for *some effect with respect to vision,* and hence in the case at bar "Specs" necessarily describes the product as well as its use. The peculiar characteristics of the device with respect to vision, and its location on the beak of the fowl for that purpose, similar to the position of eyeglasses on the human nose, makes the word definitely descriptive in a trade mark sense. The position of the Court of Appeals in this respect is not at all contrary to any of the cases cited by the petitioner.

The word "Specs" being of a definite descriptive nature, the Petitioner obviously is not entitled to the exclusive use thereof. In the case at bar, Respondent used the word "Goggles". There is no showing in this record, and Petitioner has not asserted that he has ever used the word "Goggles" as a trade mark, or any other word but "Specs". Clearly there was no error on the part of the Court of Appeals in this respect and the fifth question on which review is asked is clearly without merit.

The Sixth Question

By the sixth question, Petitioner asks this court to review the action of the Court of Appeals in determining the status of the word "Specs" as a valid trade mark, even though there had been no finding of infringement by that court.

This finding brings into issue exactly the same points as were advanced with respect to the first question, supra. It is Respondent's position that the record certified to the Appellate Court was there for all purposes, and therefore the lower court was justified in finally settling this question, as well as all other questions raised by the record. The authorities cited in the preceding discussion relative to the

first question,* apply with equal force here, and obviously for reasons stated in connection therewith, the sixth question is without merit.

The Seventh Question

The seventh question puts in issue Petitioner's challenge of the legality of the determination by the Court of Appeals that the showing as to alleged confusion in trade was not adequately established by the plaintiff (R. 204).

It appears to be the Petitioner's opinion that mere assertion of possibility of confusion is sufficient to establish unfair competition, i.e. that it is unnecessary to support the charge by any convincing evidence.

Numerous cases are cited (p. 24) allegedly in support of this contention, but an examination of these authorities definitely shows that they do not bear out Petitioner's assertions.

A typical example is the reference to Nims on Unfair Competition and Trade Marks, Second Edition, Section 335, referred to on page 24. It will be noted that Nims states that cases of confusion must be decided on *the facts as to the marks used by the parties* and on *evidence of the market conditions surrounding the every day use of the marks* to determine whether or not the defendant's acts will be likely to cause confusion.

Entirely aside from the general rule, as stated in Nims, the lower court in the authorities pointed out in its opinion (R. 203, 204) states the correct rule of law to be followed in these cases. That is, the lower court followed the ruling of this court in Pecheur Lozenge Company, Inc. vs. National Candy Co. Inc., 315 U. S. 666, 667, to the effect that where jurisdiction of this question rests upon diversity of

* Pages 5 and 6, supra.

citizenship, the rights of the parties in respect thereto are to be determined *according to local law*. There is no dispute between the parties that the local law applicable is the law of the State of New Jersey.

Petitioner has not pointed out a single authority which contradicts any of the Federal or State citations in the opinion of the lower court (R. 203, 204). These cases uniformly hold that some showing of actual confusion, or at least some facts indicating a probability of confusion, should be made before any ruling on the question is justified. In the case at bar (R. 96a, 97a) specimens of the Respondent's labels in actual use were offered in evidence without objection. No labels of the Petitioner were ever filed for comparison, and there is no evidence whatever of any confusion having arisen by reason of Respondent's use of the word "Goggles" on the labels exemplified in Exhibits D-22 and D-23.

The only evidence of unfair competition is found in three letters (R. 162a). These are referred to in the opinion of the Court of Appeals at page 204. Petitioner admitted that these letters reached him in the regular mail delivery (R. 61a-62a). They were not addressed to the Respondent. Petitioner personally answered each of these communications. No other persons, except Petitioner's employees and his attorney, ever knew anything about them. (R. 85a to 88a). On this state of facts, and particularly in view of Petitioner's extensive advertising (R. 84a and 89a) the Court of Appeals was clearly justified in holding that "the meager instances of confusion to which the plaintiff points are more properly attributable to carelessness or inattention on the part of the inquirers rather than to the conduct of the competitor".

The fact is that if Petitioner's theory in this respect were sustained, it would be very easy for anybody to establish a case of unfair competition by merely alleging the con-

clusion that such existed. Such a situation would be intolerable. The seventh question is definitely without merit and should be disregarded.

CONCLUSION.

In conclusion, it is iterated that

(1) a careful review of the questions raised in the petition clearly indicates that the Petitioner has failed to base his petition on any ground coming within the purview of any portion of Rule 38, Section 5.

(2) Even if the petition should be held to come within any of the provisions of Rule 38, Section 5, the seven questions raised here are each and every one without merit, because they are unsupported by settled authority, and do not state sufficient reasons to justify this court in taking the case for review.

Respectfully submitted,

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